

REMARKS/ARGUMENTS

By this Amendment, claim 1, 7 and 9-14 have been amended. Claims 27 and 28 have been added. Claims 3 and 4 have previously been allowed. Claims 1, 3-14 and 27-28 remain in the application.

Claim Amendment Support

The amendment to claim 1 related to a second shim is supported, for example, by paragraph [0051] of the published application (US20060089653A1) (page 14, lines 6-11):

“As illustrated in FIGS. 1-2, the kits 10 may include a plurality of femoral shims 26, 28, 30 of different thicknesses, each with a structure as described above. For example, a group of four femoral shims could be provided in sequential thicknesses of 2 mm, 10 mm, 12.5 mm and 15 mm may be provided. It should be understood that these dimensions are provided by way of example only; the invention is not limited to any particular dimension unless expressly called for in the claims.”

Paragraph [0054] also supports the reference to a second shim. (See page 15, lines 19-20: “The kit may include a plurality of tibial shims 32, 34 of different thicknesses.”)

Claim Objections

Claim 1 has been amended to replace “guide arm” with –guide arm portion—. Dependent claims 7 and 9-14 have been similarly amended.

Claim Rejections – 35 USC §112

Claim 1 has been amended to refer to the planar guide arm contact surface and the planar bone contact surface of each shim. Accordingly, the rejection under §112 is believed to have been overcome.

Claim Rejections – 35 USC §102

The rejection of claims 1-2, 5-6, 10 and 14 under 35 U.S.C. §102(b) as being anticipated by White (US Patent No. 5,662,656) is respectfully traversed.

In the Office Action, element 25 of White is identified as a shim arm. However, White is not seen to disclose or suggest a kit for locating a distal femoral resection plane where the kit includes more than one shim, where the shims have different thicknesses. Accordingly, White does not anticipate claim 1 or its dependent claims and claim 1 and its dependent claims are patentable over White.

The rejection of claims 1, 5 and 8-10 under 35 U.S.C. §102(b) as being anticipated by Fargie et al. (US Patent No. 4,736,737) is respectfully traversed. Assuming that elements 30 of Fargie et al. are shims, these elements are not seen as having different thicknesses. Fargie et al. does not anticipate claim 1 or its dependent claims and claims 1, 5 and 8-10 are patentable over Fargie et al..

Claim Rejections – 35 USC §103

The rejection of claims 7-8 and 11-13 under 35 U.S.C. §103 as being unpatentable over White (US Patent No. 5,662,656) is respectfully traversed.

As discussed above, assuming element 25 of White to comprise a shim arm, White does not suggest providing a second discrete shim arm that is separately mountable to the guide arm portion and that has a different thickness than the first shim arm. Accordingly, claims 11-13 are dependent upon claim 1 and are accordingly patentable over White as well.

Conclusion

It is believed that all of claims 1, 3-14 and 27-28 are in condition for allowance. Reconsideration and reexamination of all of claims 1, 3-14 and 27-28 is respectfully requested. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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